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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,400	04/13/2004	Ralph Bauer	1055-A4363	3239
34456 7590 02/25/2008 LARSON NEWMAN ABEL POLANSKY & WHITE, LLP 5914 WEST COURTYARD DRIVE SUITE 200 AUSTIN, TX 78730				
EXAMINER YOON, TAE H				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
02/25/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/823,400

Applicant(s)

BAUER ET AL.

Examiner

Tae H. Yoon

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 30 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-8, 10-22, 24-34, 53 and 54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, 10-22, 24-34, 53 and 54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4, 6-8, 10-22, 24-34, 53 and 54 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the recited flow and leveling of at least 6 mils for a surface solution containing an activated boehmite particles used in examples, does not reasonably provide enablement for the recited flow and leveling of at least 6 mils for the recited generic surface coating base and boehmite particles (non-activated). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Applicant's own statement and Exhibit A show that unactivated samples do not exhibit distinct and desirable thixotropic properties. Thus, the examiner believes that use of unactivated samples encompassing the instant claims would not yield flow and leveling of at least 6 mils, and applicant failed to show otherwise. Also, even with use of said activated boehmite particles in a coating solution, said flow and leveling of at least 6 mils would dependent on other components amounts thereof present in said coating solution.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims

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are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6-8, 10-22, 24-34, 53 and 54 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 6 of copending Application No. 10/978,286. Although the conflicting claims are not identical, they are not patentably distinct from each other because the coating solution of said copending application encompasses the instantly recited properties, amounts of components and any additives inherently or because it would be obvious to one skilled in the art at least.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. Applicant failed to submit a terminal disclaimer.

There was a typo (claim 5 rather than claim 6 of copending Application) in the previous office action. However, the examiner stated that a coating solution is recited in the claim of said copending Application. The preamble (polymer composite) of said copending Application has little probative value in view of the claim 6 wherein "the

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composite is in the form of a surface coating solution" is recited, and said composite would encompass any flow and leveling property including the instant at least 6 mils inherently since the same components are used.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 5-8, 10-22, 24-34, 53 and 54 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bugosh (US 2,915,475).

Rejection is maintained for reason of record with following response.

Applicant asserts that Bugosh is silent regarding characteristics of the coatings and paints such as flow and leveling, sag resistance and set-to-touch dry time.

But, Bugosh teaches improved leveling property of coating at col. 28, lines 32-39 since the boehmite acts as a thickener, dispersant and emulsifier. As pointed out in the last office action, use of 1-40% of said boehmite in aqueous paints such as polyacrylic esters with or without other emulsifier is taught at col. 29, lines 1-21. Thus, said aqueous paint containing 20% or 2% of said boehmite inherently possesses the instant flow and leveling value and other recited properties inherently, and applicant failed to show otherwise. A commercial latex paint has a pH greater than 7 inherently (basic, not acidic) which provides easy clean up of a brush by water, for example.

Applicant's 1.132 declaration and Exhibits therein have been considered, but found unpersuasive for following reasons;

1. A higher viscosity value for the activated boehmite particles does not necessary mean that it would yield the instant flow and leveling of at least 6 mills in a surface coating base since no particular composition for said surface coating base is recited.

2. Claim 1 recites a minimum of 0.1 wt% of boehmite particles, and the scope of claim is broader than the showing (20 wt%) even with a full credit to said Exhibits.

3. There would be no garranty that 20 wt% of activated boehmite particles in any surface coating base would provide the instantly recited properties such as flow and leveling of at least 6 mils.

4. Easier and concrete showing would be adding various amounts (such as 0.1 wt%, 2 wt%, 10 wt%, for example) of (activated) boehmite particles in commercial paints found in home improvement stores, and applicant failed to do so. It is puzzling.

Claims 1-4, 5-8, 10-22, 24-34, 53 and 54 are rejected under 35 U.S.C. 103(a) as obvious over Bugosh (US 2,915,475) and Gernon et al (US 2006/0106129 A1)..

Rejection is maintained for reason of record with above and following response.

The examiner stated that the instant properties would be inherent in paints containing boehmite particles taught by Bugosh. Gernon et al further support the examiner's position for following reasons;

1. A commercial latex paint has a pH greater than 7 such as 9.0+0.2 as taught in example 2. Thus, such pH also inherently activates added boehmite particles of Bugosh.

2. Set to dry time of 10 minutes are seen in table 3, and the instant value is common for a latex paint.

3. Viscosity values in KU (83-93) in said table 3 are higher than KU values shown in the instant example of table 1 (68 and 72), and very good leveling score of 8 is also seen. Thus, said higher viscosity would yield the instant flow and leveling value and sag resistance.

Claims 1-3, 6-8, 10-12 and 15-21 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yoshino et al (US 6,576,324).

Rejection is maintained for reason of record with above response under Bugosh.

Claims 1-3, 6-8, 10-12 and 15-21 are rejected under 35 U.S.C. 103(a) as obvious over Yoshino et al (US 6,576,324).

Rejection is maintained for reason of record with above response

Claims 1-3, 6-8, 10-22, 24-34, 53 and 54 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Napier (US 3,357,791).

Rejection is maintained for reason of record with above response under Bugosh.

Applicant asserts that Napier is silent regarding characteristics of the coatings and paints such as flow and leveling, sag resistance and set-to-touch dry time.

An aqueous paint containing 20 wt% or 2 wt% of said boehmite inherently possesses the instant flow and leveling property, sag resistance and set-to-touch dry time inherently, and applicant failed to show otherwise.

Claims 1-4, 6-8, 10-22, 24-34, 53 and 54 are rejected under 35 U.S.C. 103(a) as obvious over Napier (US 3,357,791) with or without Bugosh (US 2,915,475), and further in view of Gernon et al (US 2006/0106129 A1)...

Rejection is maintained for reason of record with above and following response.

The examiner stated that the instant properties would be inherent in paints containing boehmite particles taught by Napier. Gernon et al further support the examiner's position for following reasons;

1. A commercial latex paint has a pH greater than 7 such as 9.0+0.2 as taught in example 2. Thus, such pH also inherently activates added boehmite particles of Napier.
2. Set to dry time of 10 minutes are seen in table 3, and the instant value is common for a latex paint.
3. Viscosity values in KU (83-93) in said table 3 are higher than KU values shown in the instant example of table 1 (68 and 72), and very good leveling score of 8 is also seen. Thus, said higher viscosity would yield the instant flow and leveling value and sag resistance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tae H Yoon
Primary Examiner
Art Unit 1796

THY/February 16, 2006

/Tae H Yoon/